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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,278	09/28/2005	Bob Rockoffs	R0100.0001	1554
32173 7590 11/24/2008 DICKSTEIN SHAPIRO LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) NEW YORK, NY 10036-2714				
EXAMINER VARNUM, RYAN A				
ART UNIT		PAPER NUMBER		
4118				
MAIL DATE		DELIVERY MODE		
11/24/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,278

Applicant(s)

ROELOFFS, BOB

Examiner

RYAN VARNUM

Art Unit

4118

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15, 16 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15, 16 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is responsive to the amendment filed on 9/28/2005. As directed by the amendment: claims 4, 8-13, 15-16, and 20-25 have been amended, and claims 14, 17-19, and 26-32 have been cancelled. Thus, claims 1-13, 15-16, and 20-25 are presently pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 9, as recited states a clamping device having a "rigid/fixed" connection. It is unclear to the examiner whether applicant intends to claim the device having a rigid connection or a fixed connection or both a rigid and fixed connection.

5. Claim 13 recites the limitation "the enclosure" in the body of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

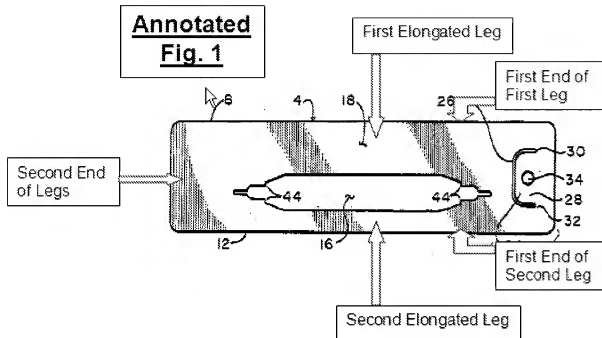
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4, 8-9, 11, 13, 15, and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Dopp (US Patent No. 4,706,995).

8. In re Claim 1, Dopp discloses a combination writing device (Fig. 1), comprising: a substantially flat writing member 20 (Fig. 1) which is provided with a writing tip 70 (Fig. 1), and at least a clamping device 4/24 ("card" and "tab"; Fig. 1) connected to the writing device for clamping the writing member in an edge area of a flat material, the clamping device comprising at least a first elongated leg and a second elongated leg which extend substantially parallel to an edge of the writing member facing thereto, the writing member and the clamping device take a fixed position relative to each other. (Fig. 1; See also Annotated Fig. 1 below; Column 2, Lines 47-51 and 64-68).

Annotated
Fig. 1



11. In re Claim 4, Dopp further discloses the first leg and the second leg of the clamping device are connected to the writing member near the writing tip thereof. (See Annotated Fig. 1 above; Fig. 2; Column 3, Lines 4-24).
12. In re Claim 8, Dopp further discloses the writing member and the clamping device extend substantially in a same plane. (Fig. 1; Column 1, Lines 58-62; "co-planar relationship").
13. In re Claim 9, as best understood, Dopp further discloses the clamping device has a rigid/fixed connection ("channels" 40/42 and "tabs" 44; Fig.'s 1 and 2) with the writing member. (Column 1, Lines 58-63; Column 3, Lines 9-24).
14. In re Claim 11, Dopp further discloses the writing member over at least a part of the circumference thereof is provided with grooves 40 and 42 ("channels"; Fig. 2) for a detachable connection to tongue parts 44 ("tabs"; Fig. 1) of the clamping device. (Column 3, Lines 9-24).
15. In re Claim 13, Dopp discloses the clamping device and writing member being provided with a part whereby at least a part of the clamping device and writing member thereof can be enclosed for a detachable connection with the other of the clamping device or writing member. (Fig.'s 1 and 2; Column 3, Lines 9-24).
16. In re Claim 15, Dopp further discloses the enclosure comprising a partial envelopment. (Fig. 1; Fig. 2; Column 3, Lines 4-8; "either side facing outwardly").
17. In re Claim 21, Dopp further discloses the detachable connection comprising a click feature. (Column 3, Lines 9-24; "flexible and resilient material...bent or pushed...thereafter 'spring' back into the channel...").

18. In re Claim 22, Dopp further discloses the writing tip 70 (Fig. 1) being situated at least partially within the area of the clamping device. (Fig. 1; Column 1, Lines 58-65; Column 2, Lines 61-63).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dopp. Dopp discloses the claimed invention except that the connection is reversed with the tongue parts being on the clamping device and the grooves being on a circumference of the writing member. (Fig.'s 1 and 2; Column 3, Lines 9-24). It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to reverse the positioning of the tongue and groove parts, for the purpose of providing a detachable connection between the writing member and clamping device, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

21. Claims 1, 5-7, 10, 16, 20, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chu (US Patent No. 5,632,564) in view of Montan (US Patent No. 1,629,835).

22. In re Claims 1 and 5-6, Chu discloses a combination writing device, comprising a substantially flat writing member 1 (Fig.'s 1-3) which is provided with a writing tip 4 (Fig. 3), and a clamping device 3 (Fig.'s 1-2), connected to the writing device for clamping the writing member in an edge area of a flat material, the clamping device comprising a first elongated leg 3 (Fig.'s 1-2) which extends substantially parallel to an edge of the writing member facing thereto, the writing member and the clamping device take a fixed position relative to each other. (Fig.'s 1-3). Chu further discloses the first end of a first leg of the clamping device is connected to the writing member near the writing tip thereof. (Fig.'s 1 and 2).

23. Chu does not disclose the clamping device comprising at least a first elongated leg and a second elongated leg which extend substantially parallel to an edge of the writing member facing thereto, or the first leg of the clamping device at a first end thereof is connected to the writing member, in that the second leg of the clamping device at an end thereof is connected to a second end of the first leg, and in that a second end of the second leg is free.

24. Montan however, teaches a clamping device comprising a first elongated leg 10 ("outside arm") and a second elongated leg 11 ("inside arm") which extend substantially parallel to an edge of the writing member facing thereto, (Fig.'s 1 and 2; Lines 20-31); the first leg of the clamping device at a first end 13 thereof is connected to the writing

member, in that the second leg of the clamping device at an end 14 thereof is connected to a second end 16 of the first leg, and in that a second end 15 of the second leg is free, (See Montana, Fig.'s 1 and 2), for the purpose of providing a clip with increased security. Therefore, it would have been obvious to a person having ordinary skill in the art, at the time of the invention, to modify the clamping device of Chu with a dual arm structure, as taught by Montan, for the purpose of increasing the security of the clamping device.

25. In re Claim 16, Chu further discloses the clamping device 3 (Fig.'s 1-2) and writing member 1 (Fig.'s 1-2), edges capable of engaging at least a part of the other of the clamping device and writing member for a detachable connection 2 therewith. (Fig.'s 1-2).

26. In re Claim 20, Chu further discloses the detachable connection 2 comprising a clamping connection 2 ("cap"). (Fig.'s 1-3; Column 2, Lines 45-52).

27. In re Claims 23-24, Chu further discloses a cap 2 for closing off the writing tip; said cap being integrated in the detachable part of the clamping device. (Fig.'s 1-3).

28. In re Claim 25, Chu further discloses the writing member comprising an ink reservoir 6 which is connected to the writing tip 7. (Fig. 5; Column 2, Lines 53-58).

29. In re Claims 1, 5, and 7; Chu discloses a combination writing device, in another embodiment (Fig. 10), comprising a substantially flat writing member 20 which is provided with a writing tip 22, and a clamping device 15 connected to the writing device for clamping the writing member in an edge area of a flat material the clamping device

comprising a first elongated leg 15 which extends substantially parallel to an edge of the writing member facing thereto, characterized in that the writing member and the clamping device take a fixed position relative to each other. (Fig. 10). Chu further discloses the first end of the first leg of the clamping device is connected to a part of the writing member facing away from the writing tip. (Fig. 10).

30. Chu does not disclose "the clamping device comprising at least a first elongated leg and a second elongated leg which extend substantially parallel to an edge of the writing member facing thereto", or "the first leg of the clamping device at a first end thereof is connected to the writing member, in that the second leg of the clamping device at an end thereof is connected to a second end of the first leg, and in that a second end of the second leg is free."

31. Montan however, teaches a clamping device comprising a first elongated leg 10 ("outside arm") and a second elongated leg 11 ("inside arm") which extend substantially parallel to an edge of the writing member facing thereto, (Fig.'s 1 and 2; Lines 20-31); the first leg of the clamping device at a first end 13 thereof is connected to the writing member, in that the second leg of the clamping device at an end 14 thereof is connected to a second end 16 of the first leg, and in that a second end 15 of the second leg is free, (See Montana, Fig.'s 1 and 2), for the purpose of providing a clip with increased security. Therefore, it would have been obvious to a person having ordinary skill in the art, at the time of the invention, to modify the clamping device of Chu with a dual arm structure, as taught by Montan, for the purpose of increasing the security of the clamping device.

32. In re Claim 10, Chu further discloses the writing tip being situated outside of the area of the clamping device. (Fig. 10).

Conclusion

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN VARNUM whose telephone number is (571) 270-7853. The examiner can normally be reached on Monday - Friday, 9:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Quang Thanh can be reached on (571) 272-4982. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. V./
Examiner, Art Unit 4118

/Quang D. Thanh/
Supervisory Patent Examiner,
Art Unit 4118